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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,516	10/15/2001	Hwai-Tay Lin	CFP-1489	5040

7590

11/19/2002

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EXAMINER

DURAND, PAUL R

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/978,516

Applicant(s)

LIN, HWAI-TAY

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1,2 and 7, it is not clear which end wall is being claimed.

In regard to claim 3, is indefinite in that it is not clear what is the location and orientation of the plane.

Claim 8 recites the limitation "the annular wall" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golsch (US 4,932,480) in view of Boothby et al (US 5,617,925).

In regard to claim 1, Golsch discloses the invention substantially as claimed including a tool 10, a head portion, which holds cylinder 20, inner peripheral wall 22,

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with plural ports 80, end wall 24, with through hole 36, piston 26, with mounted driving element 32 and bumper 70 (see figures 1 and 2). What Golsch does not disclose is a bumper comprised of two pieces each having a different rigidity. However Boothby teaches that it is old and well known in the art of tool driving to provide plural bumper elements 102 and 104, with a different rigidity for the purpose of reducing tool wear (see Fig. 5 and C9, L32-38). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the tool of Golsch with the bumper elements as taught by Boothby for the purposes of reducing tool wear.

In regard to claims 4-6 and 8-10, Golsch discloses the invention substantially as claimed including a head portion that contains ports 80 and gaps 112 not in contact with inner peripheral wall 22 and an annular connecting wall 82 at a different level than of the inner peripheral wall 22 (see figures 1 and 2). What Golsch does not disclose is a tool comprised of combustion power. However, the examiner takes Official Notice that it is old and well known in the art to provide a driving tool powered by combustion for the purpose of increasing operational efficiency.

5. Claims 2,3,7 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golsch in view of Boothby et al and in further view of Kemper et al (US 4,050,505).

Golsch and Boothby disclose the invention substantially as claimed including a bumper 70, flanged section 108 that abuts annular connecting wall 82, annular connecting wall 82 at a different level than of the inner peripheral wall 22 and plural ports 80. What Golsch and Boothby do not disclose is the specifics of a two piece

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bumper. However Kemper teaches that it is old and well known in the art to provide a two piece bumper that has an enlarged second section 9, that is less rigid than a first section 7, and abuts an end wall 13 and an inner wall for the purpose of reducing tool wear (see Figs. 1,2 and C2, L65 – C3, L7). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the tool of Golsch with the bumper elements as taught by Kemper for the purposes of reducing tool wear.

In regard to claim 13, Golsch discloses the invention substantially as claimed including a head portion that contains ports 80 and gaps 112 not in contact with inner peripheral wall 22 and a annular connecting wall 82 at a different level than of the inner peripheral wall 22 (see figures 1 and 2). What Golsch does not disclose is a tool comprised of combustion power. However, the examiner takes Official Notice that it is old and well known in the art to provide a driving tool powered by combustion for the purpose of increasing operational efficiency.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Doyle, Bade, Maurer et al, Elliesen, Becht, Yamada et al and Deieso have been cited to show devices having similar structure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 703-305-4962. The examiner can normally be reached on 0700-1730, Monday - Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Paul Durand  
November 12, 2002

A handwritten signature in black ink, appearing to read 'Rinaldi I. Rada', with a long horizontal flourish extending to the right.

Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700